

**REMARKS**

Claims 1 – 14 were pending in the present application when last examined and were subject to a restriction requirement. Claims 1 – 8 are elected and the remaining claims are being canceled. Claims 1 – 8 remain pending in the present application.

**Restriction Requirement**

In sections 1 – 5 of the Office Action, the Examiner required restriction of the invention to one of three groups. Applicants confirm the election of group I comprising claims 1 – 8 and are canceling the remaining claims.

**Objection to the Specification**

In sections 6 – 7 of the Office Action, the Examiner objected to the abstract due to length. In response, Applicants are replacing the abstract with a shorter one that is less than 150 words. Accordingly, Applicants request withdrawal of this objection.

**Rejection under 35 U.S.C. § 102(e)**

In sections 9 – 10 of the Office Action, the Examiner rejected claims 3 – 4 under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,138,146 to Moon et al. (hereinafter referred to as "Moon"). Applicants respectfully traverse this rejection.

Applicants respectfully submit that claim 3 is allowable over the cited art by at least reciting:

establishing a communications channel with a client computer system;  
receiving information corresponding to new email events from the client  
computer system; and  
storing the information corresponding to the new email events in a  
database.

In contrast, Moon discloses transmitting and receiving email messages and not information corresponding to email. For example, at column 4, lines 22 – 25 of Moon discloses “...(1) receive and transmit E-mail messages internal to the private network 12; (2) transmit E-mail messages to the public network 14; and (3) receive E-mail messages from the public network 14.” Nowhere in the passages cited by the Examiner does Moon disclose receiving

information corresponding to email events (e.g., receipts) and storing the corresponding information in a database. Accordingly, Applicants submit that claim 3 is allowable over the cited art. Further, as claim 4 recited language substantially similar to claim 3, is should be allowable for at least the same reason. Therefore, Applicants respectfully request withdrawal of this rejection.

In sections 11 – 12 of the Office Action, the Examiner rejected claims 5 – 6 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,073,165 to Narasimhan et al. (hereinafter referred to as “Narasimhan”). Applicants respectfully traverse this rejection.

Applicants respectfully submit that claim 5 is patentable over Narasimhan by at least reciting:

- obtaining filter control data;
- examining email data against the filter control data;
- determining at least one transfer protocol for the email data based on the examination; and
- forwarding the email data according to the at least one transfer protocol via a computer network to a database.

In contrast, Narasimhan does not disclose determining transfer protocols for the email data based on the examination using the filter control data. Instead, Narasimhan teaches using only a single message format (i.e., HTTP) and a single communication mechanism (i.e., POST). For example, at column 5, lines 42 – 49, as cited by the Examiner, Narasimhan recites “[i]n one embodiment, the computer message may be an HTTP message to be communicated using the POST mechanism.” Nowhere in the passages cited by the Examiner does Narasimhan teach determining a protocol and forwarding the email using the determined protocol. Accordingly, Applicants submit that claim 5 is allowable over the cited art. Similarly, claim 6 recites language substantially similar to claim 5 and therefore should be allowable over the cited art for at least the same reason. Therefore, Applicants respectfully request withdrawal of this rejection.

#### **Rejections under 35 U.S.C. § 103(a)**

In sections 14 – 16 of the Office Action, the Examiner rejected claims 1 – 2 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,510,455 to Chen et al. (hereinafter

referred to as “Chen”) in view of U.S. Patent No. 6,118,856 to Paarsmarkt et al. (hereinafter referred to as “Paarsmarkt”). Applicants respectfully traverse this rejection.

Applicants respectfully submit that claim 1 is allowable over the cited art by at least reciting:

- examining start criteria;
- determining whether the start criteria have been met;
- obtaining new email events from an email database after the start criteria have been met; and
- forwarding information corresponding to the new email events via computer network to a database.

In contrast, Paarsmarkt discloses forwarding email itself to a remote device and not forwarding information corresponding to new email events to a database. For example, in column 2, lines 15 – 17, which was cited by the Examiner, Paarsmarkt discloses “...a user can specify conditions under which a received email is to be forwarded to a remote device.” Further, at column 2, lines 25 – 29, which was also cited by the Examiner, Paarsmarkt recites “[t]he user may instruct the apparatus to periodically actively retrieve email from an ISP and forward it to a remote device, and the user may provide such an instruction either at the apparatus or from a location remote therefrom.” Accordingly, even assuming Chen teaches the first three elements of the claim per the Examiner’s supposition, Paarsmarkt does not teach the fourth element and therefore the combination of Chen and Paarsmarkt cannot yield the invention claimed in claim 1. Therefore, Applicants submit that claim 1 is patentable over the cited art. Further, as claim 2 recites language substantially similar to claim 1, it should be allowable for at least the same reason. Therefore, Applicants respectfully request withdrawal of this rejection.

In sections 17 – 19 of the Office Action, the Examiner rejected claims 7 – 8 under 35 U.S.C. §103(a) as being unpatentable over Narasimhan in view of Moon. Applicants respectfully traverse this rejection.

Applicants respectfully submit that claim 7 is patentable over the cited art by at least reciting:

- obtaining filter control data;

examining email data against the filter control data;  
determining based on the examination the email data that should not be  
forwarded;  
generating receipt data identifying the email data that should not be  
forwarded; and  
forwarding the receipt data via a computer network to a database.

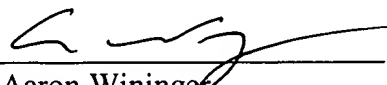
In contrast, Narasimhan discloses forwarding a filtered message to a forwarding service and not forwarding receipt data to a database. For example, at column 6, lines 19 – 21, Narasimhan recites, contrary to the Examiner's assertion, that the "paging program 368 is responsible for causing the filtered message to be sent to the appropriate forwarding service normally identified by a telephone number." Nowhere cited by the Examiner does Narasimhan disclose forwarding any sort of receipt data to a database. Accordingly, even if Narasimhan and Moon teach the other elements of the claim, their combination could not possibly lead to the invention recited in claim 7. Therefore, Applicants submit that claim 7 is patentable over the cited art. Further, as claim 8 recited language substantially similar to claim 7, it should be allowable over the cited art for at least the same reason. Therefore, Applicants respectfully request withdrawal of this rejection.

Attached hereto is a marked-up version of the changes made to the claims and specification by the current amendment. The attached page is captioned "**Version with markings to show changes made.**" Applicants respectfully requests that a timely Notice of Allowance be issued in this case as all claims are believed to be allowable over the cited art.

If the Examiner has any questions or needs any additional information, the Examiner is invited to telephone the undersigned attorney at (650) 843-3375.

Respectfully submitted,  
Mason Ng et al.

Dated: July 28, 2003  
Squire, Sanders & Dempsey L.L.P.  
600 Hansen Way  
Palo Alto, CA 94304-1043  
Telephone (650) 856-6500  
Facsimile (650) 843-8777

By   
Aaron Wininger  
Attorney for Applicants  
Reg. No. 45,229

## Version With Markings To Show Changes Made

### In the specification:

The abstract beginning on page 26, line 5 has been amended as follows:

~~A network system includes a server computer system coupled via a computer network to a client computer system, to an email computer system, and to a remote computer system. The server computer system downloads an email forwarding engine to the client computer system for enabling the email forwarding functionality on the client computer system. On the client computer system, the email forwarding engine examines start criteria, determines whether the start criteria have been met, obtains new email and/or email events from an email database, and forwards the new email and/or email events to the server computer system. The server computer system maintains them in a database. The email forwarding engine includes a filter for examining the email and/or email events against filter control data to determine the data to transfer and the desired transfer protocols. The server computer system stores an independently modifiable copy of user preferences, e.g., start criteria, stored on the client computer system to enable remote modification of the user preferences. In accordance with a configuration check schedule, the client computer system determines whether any changes to the independently modifiable copy of the user preferences has been made, and if so modifies its copy of the user preferences.~~ The system and method enables the automatic routing of email and information corresponding to email to a database. The system and method also enables the filtering of email, determination of a protocol based on the filtering, and the transfer of the email according to the determined protocol.

### In the claims:

Claims 9 –14 have been canceled.